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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,399	04/03/2006	Jurgen Dorn	1016710013P	9700
34284	7590	10/08/2009	EXAMINER	
Rutan & Tucker, LLP. 611 ANTON BLVD SUITE 1400 COSTA MESA, CA 92626			EVERAGE, KEVIN D	
			ART UNIT	PAPER NUMBER
			3734	
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			10/08/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,399	Applicant(s) DORN ET AL.	
	Examiner KEVIN EVERAGE	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5,6 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,7-14 and 16-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3 April 2006 & 11 December 2006.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species A, claims 1, 4, 7-14 and 16-29 in the reply filed on July 9, 2009 is acknowledged. Claims 2, 3, 5, 6 and 15 are withdrawn from consideration.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1, 4, 7-10, 13, 14, 16, 18, 21, 23, 25 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorn et al. (US 2002/0183826 A1).**

Dorn et al. ("Dorn") discloses a retrieval catheter comprising:

a catheter wall (54) defining a catheter lumen and a distal tip that is tapered toward an open distal orifice (see Paragraph 75) defining a distal end of the catheter lumen the wall over the length of the tapered tip configured to distend to expand the distal orifice (see Paragraph 91);

a distender (56) disposed in the catheter lumen and configured to press radially outwardly the catheter wall at the distal tip to expand the distal orifice;

the distender having a distal end annulus and a proximal end annulus separated by a radially outward-facing circumferential wall and an axial lumen extending through

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the distender between said distal and proximal annuli (see Figures 2a-2d);

a pusher shaft (64) that extends proximally beyond a proximal end of the catheter lumen and that is configured to push the distender distally until the distal end annulus is distal of the catheter distal orifice and the open distal orifice of the catheter is distended (see Figures 5 and 6 for distension of catheter distal orifice caused by distal end annulus of distender);

wherein the catheter is configured as an over-the-wire catheter (see Paragraph 58);

including a guide catheter with a lumen to receive the retrieval catheter (see Paragraph 27);

wherein the guide catheter has a tapered distal end portion and the retrieval catheter is a snug fit with a distal end orifice of the tapered distal end portion of the guide catheter (see Paragraph 29);

wherein the distender comprises radiopaque material (60);

wherein the catheter wall includes an annular radiopaque marker adjacent the distal tip (80);

wherein the distender distal end annulus (76) exhibits an end face transverse to the axis of the lumen of the distender (see Figure 2c);

further comprising a device to be retrieved (152), the device including a pull line (150) having a length to extend from the device to at least the proximal end of the catheter lumen, the distender distal end annulus configured to receive at least a proximal portion of the device (see Paragraph 86);

wherein the device is a filter (see Figure 3J) for filtering passage of bodily fluid within a bodily lumen; and

wherein the catheter shaft includes a first opening (74) in a wall thereof positioned adjacent the distal tip and a second opening (67) in the catheter shaft wall spaced proximally from the first opening.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 17, 22, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorn et al. (US 2002/0183826 A1).**

Dorn discloses the pusher shaft being a metal pusher rod (see Paragraph 72) bonded to the distender body (see Figure 2d) but does not disclose the pusher shaft comprising a stainless steel hypotube. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the pusher shaft to comprise a stainless steel hypotube, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Dorn discloses the pusher element being a rod but does not disclose the pusher element including a lumen, a proximal opening and a distal opening. It would have

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been an obvious matter of design choice to configure Dorn's pusher rod with the claimed configuration, since applicant has not disclosed that the lumen or openings solve any stated problem or is for any particular purpose and it appears that the invention would perform equally well with such common configuration.

Dorn discloses the catheter shaft having a guide catheter (see above) and an aspirating function through the first and second openings (see Paragraph 67) but does not disclose the catheter shaft disposed in a lumen of the guide catheter having an aspirating position wherein the first opening is distal to the guide catheter distal tip. However it would have been obvious to someone of ordinary skill in the art at the time of the invention to extend the catheter shaft past the distal end of the guide catheter distal tip at the treatment site (where the guide catheter has served its purpose) to perform the aspirating function, and the second opening would have likewise been proximal thereto in the guide catheter lumen.

6. Claims 1, 4, 7, 11, 12, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Vale et al. (US 2002/0058963 A1) in view of Dorn et al. (US 2002/0183826 A1).

Vale et al. ("Vale") discloses a retrieval catheter comprising:

a catheter wall (10) defining a catheter lumen and a distal tip that is tapered toward an open distal orifice (71) defining a distal end of the catheter lumen the wall over the length of the tapered tip configured to distend to expand the distal orifice (see Paragraph 78);

a distender (11) disposed in the catheter lumen and configured to press radially outwardly the catheter wall at the distal tip to expand the distal orifice;

the distender having a distal end annulus and a proximal end annulus separated by a radially outward-facing circumferential wall and an axial lumen extending through the distender between said distal and proximal annuli (see Figures 10-12);

wherein the distender comprises an annular distender ring and a frusto-conical annular element co-axial with said distender ring, the annular element positioned proximal of the distender ring with its larger diameter end contiguous therewith (see figure below);

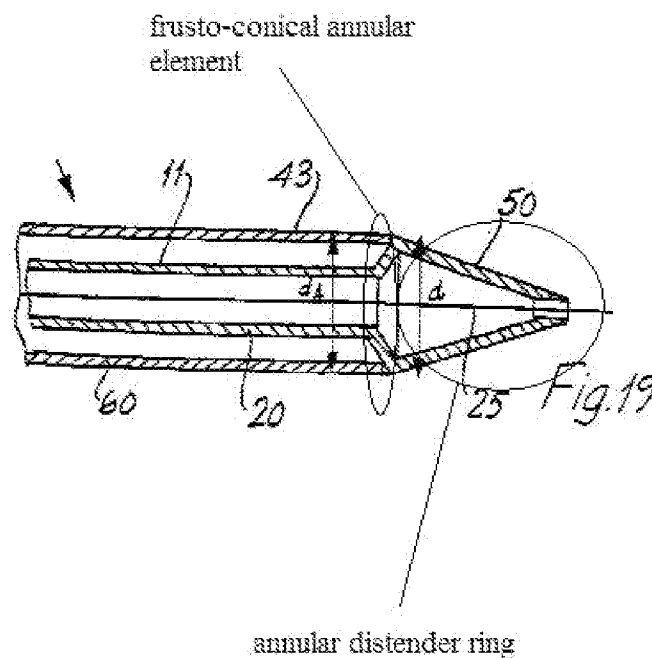
wherein the distender ring comprises radiopaque material (see Paragraph 73);

wherein the distender includes a return cone positioned about an outer surface of the body proximal of the annular element, the return cone having a frusto-conical configuration with a large diameter end approximately equivalent to the outside diameter of the annular element, the large diameter end contiguous with the annular element (The figure below shows the large diameter end being *approximately equivalent* to the outside diameter of the annular element. Other embodiments, such as Fig. 15 of Vale show an equivalent diameter. It would have been obvious to someone of ordinary skill in the art at the time of the invention to set the diameters equivalent to each other for ease of transition as the distender is retracted back into the catheter lumen);

wherein the annular element and return cone are bonded to the body by an adhesive. The claimed phrase "bonded to the body by an adhesive" is being treated as

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a product by process limitation; that is any process of bonding the annular element and return cone to each other creates the claimed apparatus. As set forth in MPEP 2113, product by process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. MPEP 2113. The annular element and return cone disclosed by Vale are integrally bonded to one another.



Vale does not disclose a pusher shaft that extends proximally beyond a proximal end of the catheter lumen and that is configured to push the distender distally until the distal end annulus is distal of the catheter distal orifice and the open distal orifice of the catheter is distended. However Dorn discloses a pusher shaft for a similarly functioning retrieval apparatus that allows the user to control the distender from a proximal handpiece (see Paragraph 72). It would have been obvious to someone of ordinary skill in the art at the time of the invention to equip the distender disclosed by Vale with pusher shaft as disclosed by Dorn for easier manipulation from a handpiece in light of Dorn's disclosure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN EVERAGE whose telephone number is (571)270-7485. The examiner can normally be reached on 9-5, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KEVIN EVERAGE
Examiner
Art Unit 3734

/K.E./

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3734